

REMARKS

This is an Amendment and Reply to the Office Action dated October 15, 2003. The Applicants respectfully request reconsideration and allowance of the application and the claims presently at issue in light of the amendments and remarks set forth herein.

A. Present Status of Application

Based upon entry of the Preliminary Amendment filed by the Applicants on April 25, 2003, claims 23-50 are pending in this application. In light of this Amendment and Reply, claims 23-50 remain at issue.

B. Amendment to Specification

The specification has been amended to include reference to the parent application, upon which a claim of priority is based. The Applicants submit that the claim of priority was previously made in the application documentation (and indicated on the Filing Receipt), but was inadvertently omitted from the specification.

C. Amendments to the Claims to Address Informalities

The Applicants note that many of the claims have been amended to merely address informalities with respect to syntax and transitional phrases. Accordingly, these types of amendments are not made in reply to the Examiner's rejections or to address any references of record and should not be construed as such.

D. Examiner's Rejections

In the present action, the Examiner has made the following rejections:

1. Claims 24 and 47 have been rejected under 35 U.S.C. §112(1) as failing to comply with the written description requirement. Specifically, the Examiner contends the claims contain subject matter that was not described in the specification in such a way to reasonably convey to one skilled in the relevant art

that the inventors had possession of the claimed invention at the time the application was filed.

2. Claims 38, 39, 42 and 43 have been rejected under 35 U.S.C. §112(2) as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicants regard as the invention.
3. Claims 23, 25, 26, 28, 30 and 31 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,418,845 to Helms ("Helms").
4. Claim 50 has been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,535,618 to Konieczka ("Konieczka").
5. Claim 24 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Helms.
6. Claims 27, 29, 32 and 33 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Helms in view of U.S. Patent No. 4,528,840 to Wass ("Wass").
7. Claims 34 and 36 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Helms in view of Wass and further in view of U.S. Patent No. 5,642,898 to Wise ("Wise").
8. Claims 35 and 37 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Helms in view of Wass and further in view of U.S. Patent No. 4,378,034 to Albertson ("Albertson").
9. Claims 38, 39, 42, 43 and 49 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Helms in view of Konieczka and German Patent No. DE 3827744A1 to Hoffman ("Hoffman").
10. Claims 40, 41 and 44-48 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Helms in view of Konieczka.

E. Reply to the Examiner's Rejections

The Applicant responds to the Examiner's rejections as follows:

1. Section 112(1) Rejection of Claims 24 and 47

With regard to claim 24, the Examiner contends the specification as originally filed does not include “combinations of air pressure, hydraulic pressure, and an electric motor for actuating the ram.”

Claim 24 has been amended to delete the “and combinations of these” language. This language has been deleted as it is unnecessary in this Markush group. The Applicants submit that it is understood that any combination of each of the individually recited actuation means in this Markush group would be covered by this claim without recitation of “and combinations of these” language. Based on this amendment, the Applicants respectfully request this rejection be withdrawn.

With regard to claim 47, the Examiner contends the specification as originally filed does not include “comparing a quantity of conductance, dielectric value, impedance, inductance, resistance and capacitance.”

The specification as originally filed discloses measurement of “electrical conductivity” and “electron flow” between the electrodes and the solution. (Col. 9, lines 56-57; Col. 9, line 66 to Col. 10, line 2). The Applicants submit that measurement of “electrical conductivity” may be carried out in a number of ways as understood by one of ordinary skill in the art, such as, “comparing a quantity of conductance, dielectric value, impedance, inductance, resistance and capacitance.” While admittedly not explicitly recited in the specification, the Applicants submit that this claim language is supported by the specification as understood by one of ordinary skill in the art. Accordingly, the Applicants respectfully request this rejection be withdrawn.

2. Section 112(2) Rejection of Claims 38, 39, 42 and 43

With regard to independent claims 38 and 39, and dependent claims 42 and 43, the Examiner contends the language “the electrode is in contact with the liquid” is unclear as to which electrode, i.e., the first or second electrode, thereby rendering claims these claims indefinite.

Claims 38 and 39 have been amended to further clarify that the electrode referred to is the first electrode. Accordingly, the Applicants respectfully request this rejection be withdrawn.

3. Section 102(b) Rejection of Claims 23, 25, 26, 28, 30 and 31 Based on Helms

The Examiner contends that Helms discloses the Applicants' invention as claimed in claims 23, 25, 26, 28, 30 and 31. For at least the following reasons, the Applicants respectfully traverse the Examiner's rejection.

Amended independent claim 23 requires, among other things, a seal evaluation apparatus for a container having a closure member wherein a liquid-filled tank is situated with respect to a clamp that secures the container such that at least a portion of the container extends into a liquid-filled tank and the closure of the container is submerged in the liquid within the tank. In contrast, Helms discloses a testing machine for testing an open end can body by completely submerging the can body with a solid plug member disposed therein. Helms does not disclose a testing machine that tests a container having a closure member, thereby necessitating the solid plug member. Furthermore, Helms does not disclose, nor does it teach or suggest, an evaluation apparatus wherein a container having a closure member is clamped such that at least a portion of the container extends into a liquid-filled tank and the closure of the container is submerged in the liquid within the tank, as required by claim 23.

Based at least on the forgoing, the Applicants submit that amended claim 23 is allowable over the cited art. Furthermore, claims 25, 26, 28, 30 and 31 should also be allowable over the cited art at least by virtue of their dependence from claim 23.

4. Section 102(b) Rejection of Claim 50 Based on Konieczka

The Examiner contends that Konieczka discloses the Applicants' invention as claimed in claim 50. For at least the following reasons, the Applicants respectfully traverse the Examiner's rejection.

Amended claim 50 requires, among other things, forming an aperture in a wall of the container after immersing at least a closure portion of the container in the liquid of a liquid-filled tank. The Applicants submit that Konieczka does not disclose, nor does it teach or suggest, the formation of an aperture in a wall of a container after immersion of at least a portion of the container in a liquid-filled tank. Indeed, Konieczka does not even disclose the formation of an

aperture after securing the container in a clamp.

Based at least on the forgoing, the Applicants submit that amended claim 50 is allowable over the cited art.

5. Section 103(a) Rejection of Claim 24 Based on Helms

The Examiner contends that Helms discloses the elements of claim 23 except for actuation of the ram by an electric motor, and, one of ordinary skill in the art would have known that electric motors may be used to directly or indirectly actuate the ram.

The Applicant submits that Helms does not disclose, nor does it render obvious, the Applicants' invention as claimed in claim 24. Claim 24 depends from amended claim 23 and therefore includes all of the limitations of amended claim 23. As previously stated, amended claim 23 requires, among other things, a seal evaluation apparatus for a container having a closure member wherein a liquid-filled tank is situated with respect to a clamp that secures the container such that at least a portion of the container extends into a liquid-filled tank and the closure of the container is submerged in the liquid within the tank. In contrast, Helms discloses a testing machine for testing an open end can body by completely submerging the can body with a solid plug member disposed therein. Helms does not disclose a testing machine that tests a container having a closure member, nor does it disclose an evaluation apparatus wherein a container having a closure member is clamped such that at least a portion of the container extends into a liquid-filled tank and the closure of the container is submerged in the liquid within the tank, as required by claim 23. Helms therefore fails as a primary reference.

Accordingly, the Applicants submit that claim 24 is allowable over the cited art, at least by virtue of its dependence from claim 23.

**6. Section 103(a) Rejection of Claims 27, 29, 32 and 33
Based on Helms in View of Wass**

In this rejection, the Examiner relies upon Helms as a primary reference. The Applicant notes that claims 27, 29, 32 and 33 all either directly or indirectly depend from amended claim 23. Accordingly, the Applicants submit that the Examiner's rejection of these claims should be

withdrawn based at least on the shortcomings of Helms as a primary reference with respect to amended claim 23, which have been previously set forth.

For at least the foregoing reason, the Applicants submit that claims 27, 29, 32 and 33 are allowable over the cited art.

7. Section 103(a) Rejection of Claims 34 and 36
Based on Helms in View of Wass and Further in View of Wise

In this rejection, the Examiner also relies upon Helms as a primary reference. The Applicant notes that claims 34 and 36 indirectly depend from amended claim 23. Accordingly, the Applicants submit that the Examiner's rejection of these claims should also be withdrawn based at least on the shortcomings of Helms as a primary reference with respect to amended claim 23.

For at least the foregoing reason, the Applicants submit that claims 34 and 36 are allowable over the cited art.

8. Section 103(a) Rejections of Claims 35 and 37
Based on Helms in View of Wass and Further in View of Albertson

In this rejection, the Examiner once again relies upon Helms as a primary reference. Since claims 35 and 37 indirectly depend from amended claim 23, the Applicants submit that the Examiner's rejection of these claims should also be withdrawn based at least on the shortcomings of Helms as a primary reference with respect to amended claim 23.

For at least the foregoing reason, the Applicants submit that claims 35 and 37 are allowable over the cited art.

9. Section 103(a) Rejection of Claims 38, 39, 42, 43 and 49
Based on Helms in View of Konieczka and Hoffman

The Examiner relies upon Helms as a primary reference in rejecting these claims. Since claims 38, 39, 42 and 43 are apparatus claims that all indirectly depend from amended claim 23, the Applicants submit that the Examiner's rejection of these claims should also be withdrawn

based at least on the shortcomings of Helms as a primary reference with respect to amended claim 23.

With respect to method claim 49, the Applicants submit that neither Helms, Konieczka nor Hoffmann, disclose, teach or suggest the claimed steps. At the very least, none of these references disclose, teach or suggest forming an aperture in the container with a device that penetrates a wall of the container after the container is secured in a clamp.

For at least the foregoing reasons, the Applicants submit that claims 38, 39, 42, 43 and 49 are allowable over the cited art.

10. Section 103(a) Rejection of Claims 40, 41 and 44-48
Based on Helms in View of Konieczka

The Examiner relies upon Helms as a primary reference in rejecting these claims. With respect to claims 40, 41, 44 and 45, these claims are apparatus claims that all indirectly depend from amended claim 23. Accordingly, the Applicants submit that the Examiner's rejection of these claims should also be withdrawn based at least on the shortcomings of Helms as a primary reference with respect to amended claim 23.

With respect to method claims 46-48, the Applicants submit that neither Helms nor Konieczka disclose, teach or suggest the claimed steps. At the very least, none of these references disclose, teach or suggest forming an aperture in a wall of the container after it is secured in a clamp.

For at least the foregoing reasons, the Applicants submit that claims 40, 41, 44, 45, amended claim 46, 47 and 48 are allowable over the cited art.

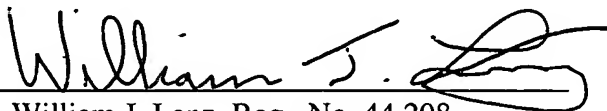
CONCLUSION

In light of the foregoing amendments and remarks, the Applicants submit that claims 23-50 are in condition for allowance. Accordingly, the Applicants request favorable reconsideration and allowance of the present application and all pending claims. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call either of the undersigned attorneys at (312) 554-3300.

Respectfully submitted.

Date: January 14, 2004

By:



William J. Lenz, Reg. No. 44,208

Customer No.: 26968

WALLENSTEIN WAGNER & ROCKEY, LTD.

311 S. Wacker Drive, 53rd Floor

Chicago, Illinois 60606-6630

Telephone 312.554.3300

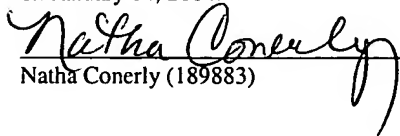
Fax No.: 312.554-3301

E-mail Address: wlenz@wwrfirm.com

Attorneys for Applicants

CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on January 14, 2004.


Natha Conerly (189883)

RECEIVED
JAN 22 2004
TECHNOLOGY CENTER 2800